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REMARKS

Claims 2-36 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

In the Office Action, claims 29-31 have not been objected to or rejected. Accordingly, Applicants submit that claims 29-31 are in condition for allowance.

The specification has been objected to for not including the term “member” as used in some of the pending claims. The term “member” has been added to the present specification. As discussed in more detail below, the term “member” is broad and the element heater 26 is a member. However, the term “member” is used to signify a broad class of items, for which a heater is one of the items. Notably, “[t]here is no requirement that the words in the claims must match those used in the specification disclosure.” M.P.E.P. §2133.05(e). Accordingly, Applicants submit that the objection to the specification is obviated.

The drawings have been objected to for not including a “‘diffuser directly applied to the area’; ‘light-diffusing panel placed over the area’; and ‘diffuser applied to the surface of the member in the area’ variously recited in claims 2, 5-7, 11, 12, 15-17, 19-22, 24-27, and 32-34.” As stated above, the term “member” is a broad term for which the heater 26 of the present application is a specific embodiment. As described in paragraph 56 of the present application and shown in FIG. 15:

[T]he illustrated heater 26 has a clear plastic layer 56 that extends across the pattern of apertures 74. The plastic layer 56 is Mylar or similar clear material, and at least the area of sections 34 at the apertures 74 is roughened or otherwise treated to form a light-spreading/diffusing surface 34 over the apertures 74.

Accordingly, the arrangements pointed out in the Office Action claimed in claims 2, 5-7, 11, 12, 15-17, 19-22, 24-27 and 32-34 are clearly shown in FIG. 15. In addition to the above, the Office Action has objected to the drawings for not including a “member.” However, as discussed above, the drawings clearly show a “member.” Accordingly, Applicants submit that the objection to the drawings should be withdrawn.

Claims 19-28 have been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. According to the Office Action, the “conductive layer” recited in claims 19 and 24 does not appear in the instant specification. Claim 19

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defines an apparatus including, among other things, a conductive layer deposited on a member and claim 24 defines an apparatus including, among other things, a member including a conductive layer. Paragraph 51 of the present application states that "[t]he heater 26 includes a foam layer 55 and a plastic layer 56 (e.g. Mylar or stiff plastic) with conductive tracings 57 thereon that form the heater element." Accordingly, the application as filed clearly teaches and enables the "conductive layer" as used in claims 19 and 24. Furthermore, as discussed above, there is no requirement that the words in the claim must match those used in the specification. Accordingly, Applicants submit that claims 19-28 are enabled.

Claims 2-28 have been rejected under 35 U.S.C §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. According to the Office Action, the term "member" renders claims 2-28 indefinite "because it is unclear as to which of the plurality of extent generally recognized definition(s) 'member' corresponds to the intended meaning of the word/term as used therein." It appears that the Office Action is stating that the term "member" is broad and therefore indefinite. However, "breadth of the claim is not to be equated with indefiniteness." M.P.E.P. §2173.04. It appears that the Office Action is stating that the term "member" is very broad as the term "member" has several definitions as found in the dictionary used by the Examiner. However, the term "member" is purposefully broad. Furthermore, a rejection of the claim under 35 U.S.C. §102 or §103 is the appropriate place to respond to broad claim terminology. See M.P.E.P. §2173.04. Accordingly, Applicants submit that claims 2-28 are definite. If the Examiner has any questions, the Examiner is requested to call the undersigned at the number below.

Claims 2, 10 and 14 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,436,741 to Crandall. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished).

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Claim 2 defines an exterior rearview mirror assembly including, among other things, an electrochromic mirror element having a front surface and a rear surface, the electrochromic mirror element having a portion allowing light to pass therethrough; a member located adjacent the rear surface of the electrochromic mirror element, the member including an area aligned with the portion of the electrochromic mirror element; a light source emitting light, the light being directed at the area; the area of the member and the portion of the electrochromic mirror element allowing light from the light source to pass therethrough; and wherein the area includes a diffuser to diffuse light passing through the electrochromic mirror element.

The prior art of record does not disclose or suggest the above noted features of claim 2. Although Applicants do not concede that the art cited by the Examiner anticipates claim 2, the Examiner has indicated that claim 2 would be in condition for allowance if it was amended to state that the mirror element is an electrochromic mirror element. Claim 2 has been so amended. Accordingly, claim 2 is in condition for allowance.

Claim 10 defines a method of assembling an exterior rearview mirror assembly including, among other things, providing an electrochromic mirror element; providing a member having an area adapted to allow light to pass therethrough; positioning the member adjacent the electrochromic mirror element; and treating the area of the member to diffuse the light passing through the member.

The prior art of record does not disclose or suggest the above noted features of claim 10. Although Applicants do not concede that the art cited by the Examiner anticipates claim 10, the Examiner has indicated that claim 10 would be in condition for allowance if it was amended to include an electrochromic mirror element. Claim 10 has been so amended. Accordingly, claim 10 is in condition for allowance.

Claim 14 defines an apparatus for an exterior of a vehicle mirror assembly including an electrochromic reflective element having inner and outer surfaces and a light source positioned to direct light toward the inner surface of the electrochromic reflective element including, among other things, a member extending between the inner surface of the electrochromic reflective element and the light source, the member including an area adapted to allow light from the light source to pass therethrough; and a light diffuser positioned over the area of the member to diffuse light passing through the electrochromic reflective element.

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The prior art of record does not disclose or suggest the above noted features of claim 14. Although Applicants do not concede that the art cited by the Examiner anticipates claim 14, the Examiner has indicated that claim 14 would be in condition for allowance if it was amended to state that the reflective element is an electrochromic reflective element. Claim 14 has been so amended. Accordingly, claim 14 is in condition for allowance.

Claim 4 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5, 587,699 to Faloon et al. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished).

Claim 4 depends from claim 2, and further defines the light source as comprising a LED. As noted above, claim 2 is believed to define unobvious patentable subject matter, and since claim 4 depends from claim 2, claim 4 is believed to define unobvious patentable subject matter. Accordingly, claim 4 is in condition for allowance.

As a final note, Applicants note that claims 3, 5-9, 11-13 and 15-36 have not been rejected over the prior art of record. Accordingly, an indication of allowability over the prior art for these claims is requested in the next communication from the Examiner.

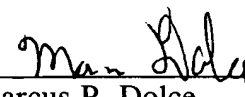
All pending claims 2-36 are believed to be in condition for allowance, and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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12/20/04
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